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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/485,601	05/04/00	STRITTMATTER	S OCR-842

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HM12/1016

EXAMINER

NGUYEN, D

ART UNIT	PAPER NUMBER
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1633

DATE MAILED:

7
10/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/485,601

Applicant(s)

Strittmatter

Examiner

Dave Nguyen

Group Art Unit

1633



☐ Responsive to communication(s) filed on _____.

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-20 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Claims 1-~~34~~ are pending.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, 6-13, 17, drawn to a protein therapy method of employing a rho protein inhibitor.

Should Group I be elected, the claims will be examined to the extent that the scope of the claims is encompassed by the elected invention.

Group II, claim(s) 1-18, drawn to a gene therapy method of employing a DNA vector comprising a rho protein inhibitor encoded DNA.

Should Group II be elected, the claims will be examined to the extent that the scope of the claims is encompassed by the elected invention.

05/10/11 (od) Group III, Claims ~~19~~ and ~~20~~, drawn a screening method comprising assaying for rho protein inhibitory activity of a test compound.

The inventions listed as Groups I, II, and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I to III provide three distinct inventive concepts as to solutions to the intended scope of each respective claimed invention. The first inventive concept for the claimed invention of Group I encompasses a protein therapy method wherein a polypeptide coding for a rho protein inhibitor is employed to generate central nervous system axon growth in a patient, whereas the second inventive concept for the claimed invention of Group II provides a distinct method to generate central nervous system axon growth in a patient by employing a gene therapy method wherein a DNA vector coding for a rho protein inhibitor is employed. In addition, the third inventive concept of the claimed invention of Group III are directed to a distinct goal wherein materially distinct method steps are employed to achieve the goal. In addition, a therapeutic protein which is essential for use in the method of Group I and a therapeutic DNA vector which is essential for use in the gene therapy method of Group II do not share a structural feature in common with respect to its intended effect and function. Furthermore, the process of assaying for potential compounds having an inhibitory activity as that of a rho protein inhibitor is completely a distinct process for solving a distinct problem. The three inventive concepts claimed in claimed in the claims of Groups I to III therefore constitute three independent inventions. Thus, the claimed invention of Group I will be considered as the main invention in the claims, see PCT Article 17(3)(a) and 1.476(c).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Dave Nguyen* whose telephone number is **(703) 305-2024**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *John LeGuyader*, may be reached at **(703) 308-0447**.

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Any inquiry of a general nature or relating to the status of this application should be directed to the *Group receptionist* whose telephone number is (703) 308-0196.



Dave Nguyen
Patent Examiner
Art Unit: 1633